

REMARKS

At the outset, Applicant notes that the Office Action Summary did not indicate whether the as-filed drawings were accepted. Applicant assumes that the drawings were accepted, but respectfully requests that the Examiner provide an indication in the next communication from the Office.

The Examiner indicated that two foreign-language references submitted in the First Information Disclosure Statement dated February 26, 2004, were not considered because the Applicant did not provide translations of these references. A Supplemental Information Disclosure Statement is submitted herewith for the Examiner's consideration.

A Substitute Specification is also submitted herewith to clarify the language of the specification, and to correct grammatical and spelling errors. A marked-up copy of the Substitute Specification is also submitted to show Applicant's changes. No new matter was added by the Substitute Specification.

In the Office Action, the Examiner rejected claims 1-15 under 35 U.S.C. § 101 for being directed to non-statutory subject matter, and rejected claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0042696 to Garcia et al. ("*Garcia*").¹

By this Amendment, Applicant has amended claims 1-9 and 11-13, cancelled claims 10, 14 and 15, and added claims 16-23. Claims 1-9, 11-13 and 16-23 are now pending.

¹ The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

Rejection of Claims 1-15 Under 35 U.S.C. § 101

The Examiner rejected independent claims 1 and 11 under Section 101 for failing to recite subject matter that would result in a useful, concrete or tangible result. (Office Action, p. 3.) Although Applicant does not agree with the Examiner, Applicant has amended claim 1 to recite, *inter alia*, "generat[ing], based on retrieved modules, tendering information for [a] facility." In light of this change, Applicant respectfully submits the claimed "tendering information" is a useful, concrete and/or tangible result.

Claim 11, although of different scope than claim 1, recites subject matter similar to that in claim 1. Accordingly, claim 11 satisfies Section 101 for the same reason as claim 1.

Claims 2-9, 12 and 13 depend from claim 1 and 11, respectively. Thus, these claims satisfy Section 101 due to the corresponding dependence from claim 1 and 11.

The Examiner also rejected claim 1 under 35 U.S.C. § 101 as non-statutory for being directed toward software, but lacking a functional storage medium. (Office Action, p. 3.) As amended, claim 1 recites, "A system for computer-aided tendering of facilities, comprising: a processor; a module library stored in a computer-readable medium ..., and a program stored in a computer-readable medium." Thus, Applicant submits that claim 1 meets the statutory requirements under Section 101 for computer-related inventions, and so do claims 2-9 which depend from claim 1.

Rejection of Claims 1-15 Under 35 U.S.C. § 102(b)

In order to properly anticipate Applicant's claimed invention under Section 102(b), each and every element of the claim in issue must be found, either expressly described or under the principles of inherency, in a single prior art reference.

Further, "[t]he identical invention must be shown in as complete detail as contained in the ... claim." See M.P.E.P. § 2131 (8th Ed., Aug. 2001), quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1235, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1 recites, *inter alia*, "a module library stored in a computer-readable medium including a plurality of modules ... categorized using a multiple-index categorization system having a plurality independent indices." Applicant respectfully traverses the rejection of claims 1-12 under 35 U.S.C. § 102(b) as being anticipated by *Garcia* because the applied reference fails to disclose at least this feature of claim 1.

Garcia apparently discloses an automated design system for utility stations in which a user may select a standard substation template and components to be included in or changed with respect to the standard template. (*Garcia*, para. 0012.) Nowhere, however, does *Garcia* disclose "multiple independent indices," as recited in claim 1.

With regard to claim 2, the Examiner asserts that *Garcia* discloses "different types of facilities," "transformer and switchgear," and "voltage" corresponding to the claimed "three independent searching indices." (Office Action, p. 5). To the extent that the rejection of claim 2 may apply to amended claim 1, Applicant notes that *Garcia* apparently discloses templates and components that are dependent upon a type of facility. For instance, *Garcia* discloses that "once [a] predetermined

"standard" substation architecture [is] selected, the user is presented with a series of options regarding which components are to be included." (*Garcia*, para. 0012.) The choice of a template or a substation type influences the subsequent selections of components. Thus, the selections described by *Garcia* are dependent on previous selections. Accordingly, *Garcia* does not disclose the claimed "multiple independent indices" for this reason as well.

Moreover, *Garcia* describes, for instance, water facilities that may include wells, well houses, and pump stations; and gas facilities that may include transmission facilities, distribution facilities, production and gathering facilities. (*Garcia*, para. 0026.) But the various design systems for utility stations, water facilities, and gas facilities appear to be separate embodiments; and, therefore, are not within "a multiple-index categorization system having multiple independent indices," as recited in claim 1.

Because *Garcia* does not disclose the above-noted feature of claim 1; the reference cannot support a rejection of claim 1 under 35 U.S.C. § 102(b). Accordingly, claim 1 is allowable over *Garcia*, and so are claims 2-9 that depend from claim 1.

Independent claims 11 and 16, although of different scope than claim 1, recite subject matter similar to that recited in claim 1. Claims 11 and 16 are, therefore, allowable over *Garcia* for the same reasons given above with respect to claim 1. Claims 12, 13, and 17-23 are also allowable due to their corresponding dependence from claims 11 and 16.

Conclusion

In light of the foregoing, Applicant respectfully requests reconsideration and allowance of the above-captioned application. Should any residual issues exist, the Examiner is invited to contact the undersigned at the number listed below.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: May 21, 2007

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Attachments:

Clean copy of Substitute Specification
Markup copy of Substitute Specification
Supplemental Information Disclosure Statement.